

Serial No. 09/855,388

Page 7

REMARKS

Claims 1-7, 9-13, and 15-19 are pending in this application.

The Office Action maintains the rejection, under 35 U.S.C. § 103, of claims 1, 9, and 15 over Sakaihara et al. (JP PN 02-79090) and McNelley (U.S. Patent No. 5,438,357), claims 2, 3, 10, and 16 over Sakaihara and Hecht (U.S. Patent No. 4,751,695), claims 4, 11, and 17 over Sakaihara and Banitt (U.S. Patent No. 5,963,247), claims 5, 12, and 18 over Sakaihara and Bricklin (U.S. Patent No. 5,680,152), claim 6 over Sakaihara and Caine (U.S. Patent No. 5,361,078), and claims 7, 13, and 19 over Sakaihara and Forcier (U.S. Patent No. 5,590,257). These rejections are respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references, when combined, must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (MPEP 2142). The prior art must suggest the desirability of the claimed invention (MPEP 2143.01).

In the "Response to Arguments" section, the Office Action alleges motivation is based on the fact that "both Sakaihara and McNelley's inventions are in the field of electronic display device." However, this does not amount to proper motivation. If the Office Action is trying to insinuate that the fact that the inventions can be combined because they are in the same field, Applicants disagree. In particular, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Yet, as discussed below, the prior art does not suggest the desirability of the combination. Furthermore, that fact that inventions are in the same field does not provide sufficient motivation to combine two particular references. There is absolutely no basis for such motivation. Thus, the fact that both Sakaihara and McNelley's inventions are in the field of electronic display devices does not provide motivation to combine the references.

Serial No. 09/855,388

Page 8

The Office Action further alleges motivation is based on ensuring an important part of the image is displayed. However, this does not amount to proper motivation. In particular, there is no disclosure of such a necessity for Sakaihara. More particularly, Sakaihara is directed to electronic stained glass. Yet, the Office Action admits McNelley only states, "tight head shots would require a quick tracking response..." However, there is no disclosure that Sakaihara uses tight head shots which would require a quick tracking response. In fact, there is no disclosure of any feature in Sakaihara that would require a quick tracking response. Sakaihara only deals with drawing patterns on window glass and using pictures to change a room interior. These patterns and pictures are not disclosed to be dynamic. Thus, there is no need for a quick tracking response to ensure an important part of an image is displayed. Furthermore, there is no disclosure in Sakaihara of using images that have important parts that need to be displayed. Additionally, there is no disclosure in McNelley of ensuring an important part of an image is displayed on the electronic stained glass of Sakaihara. Thus, ensuring an important part of an image is displayed does not amount to proper motivation to combine the references.

As discussed in the previous amendment, Applicants again assert there is no motivation to combine Sakaihara and McNelley to recite the features taught in independent claims 1, 9, and 15. In particular, Sakaihara is directed to electronic stained glass (Title) such as drawing patterns on drawings on window glass and using pictures to change a room interior (Task, solved by the invention section). McNelley is directed to a teleconferencing system (Title, Field, Summary, Description of the Preferred Embodiment, and Claims). There is absolutely no disclosure in Sakaihara of any usefulness of Sakaihara's electronic stained glass in a teleconferencing system, such as that disclosed by McNelley. Furthermore, there is absolutely no disclosure in McNelley of any usefulness of McNelley's teleconferencing system with electronic stained glass. The Office Action does not explain how one reference teaches the usefulness of using it with the other reference. In particular, the Office Action only mentions generic benefits of each reference after making a conclusory statement that the combination of such would be obvious. No motivation has been provided for combining one reference with the other.

Thus, there is no motivation to combine Sakaihara and McNelley to recite the features taught in independent claims 1, 9, and 15.

Serial No. 09/855,388

Page 9

Therefore, Applicants respectfully submit that independent claims 1, 9, and 15 define patentable subject matter. The remaining claims depend from the independent claims and therefore also define patentable subject matter. Accordingly, Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103.

CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully submit this application is in condition for allowance. Favorable consideration and prompt allowance of claims 1-7, 9-13, and 15-19 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

The Commissioner is hereby authorized to deduct the payment of the fee required for a three (3) month extension and any additional fees arising as a result of this Amendment or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

Respectfully submitted,



Matthew C. Loppnow
Attorney for Applicant
Registration No. 45,314

Dated: June 29, 2004

Phone No. (847) 523-2585
Fax No. (847) 523-2350

Please send correspondence to:
Motorola, Inc.
Intellectual Property
600 North U.S. Highway 45
Libertyville, IL 60048